

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re Patent Application for:

David L. Gilmour, et al.

Serial No.: 09/703,189

Filing Date: October 31, 2000

For: METHOD AND SYSTEM FOR
ADDRESSING A
COMMUNICATION DOCUMENT
FOR TRANSMISSION OVER A
NETWORK BASED ON THE
CONTENT THEREOF

Examiner: Nguyen, Thanh T.

Group Art Unit: 2144

Confirmation no.: 2756

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AMENDED APPEAL BRIEF UNDER 37 C.F.R. § 41.37

This amended appeal brief is responsive to the Notification of Non-Compliant Appeal Brief mailed on July 30, 2009.

This is an appeal to the Board of Patent Appeals and Interferences from the decision of the Examiner of Group 2144 set forth in the Final Office Action dated 8/17/2006, in which all claims in the above-identified application were finally rejected. This Appeal Brief is hereby submitted pursuant to 37 C.F.R. § 41.37(a). Enclosed herewith is a check in the amount required under 37 C.F.R. §§ 1.17(c) and 41.37(a) for filing an appeal brief.

I. REAL PARTY IN INTEREST

The real party in interest is the assignee of the full interest in the present invention, which is Oracle Corporation that has purchased Tacit Software, Inc., the previous assignee.

II. RELATED APPEALS AND INTERFERENCES

To the best of Appellant's knowledge, there are no appeals or interferences related to the present appeal that will directly affect, be directly affected by, or have a bearing on the Board's decision in the instant appeal.

III. STATUS OF THE CLAIMS

Claims 1-13 and 27-28 are pending in this application and stand finally rejected in the Final Office Action mailed on 8/17/2006. Claims 14-26 are canceled. Claims 1-13 and 27-28 are the subject of this appeal. A copy of the claims as they stand on appeal is set forth in the Appendix of this Appeal Brief.

IV. STATUS OF AMENDMENTS

Claims 14-26 have been canceled after receipt of the above-mentioned Final Office Action.

V. SUMMARY OF CLAIMED SUBJECT MATTER

The present invention generally relates to a technique for addressing a communication (e.g., an email) and more particularly, to automatically suggesting a recipient of a communication to the sender (see, generally, Applicants' Specification at p. 16, line 15 – p. 17, line 3).

As set forth in claim 1, the invention is a method, in which first a descriptive profile of a potential recipient of a communication is accessed (Spec.,

p. 58, lines 1-4; p. 61, line 20 – p. 62, line 2). The potential recipient is then identified as a suggested recipient of the communication, based on an evaluation of a correspondence between content of the communication and content of the descriptive profile of the potential recipient (Spec., p. 16, line 18 – p. 17, line 3; p. 58, lines 1-4; p. 61, line 20 – p. 62, line 2). For example, the evaluation may look for keywords that are found in both the body of the communication and the profile of the potential recipient. The suggested recipient is then presented to a sender of the communication, for selection as a confirmed recipient (Spec., p. 58, line 14 et seq.; Fig. 18D, element 442), after the sender has composed a draft of the communication and before transmission of the communication to an actual recipient (Spec., p. 57, lines 7-11; Fig. 18A, elements 401 & 404). The suggested recipient is presented to the sender in conjunction with an indication (Fig. 18D) of the correspondence between the content of the communication and the content of the descriptive profile of the potential recipient (Spec., p. 58, line 22 – p. 59, line 10).

Independent claim 27 includes means-plus-function elements. As set forth in claim 27, the invention includes a system for addressing a communication for transmission over a network (see, generally, Figs. 1 & 23; p. 19, line 4 – p. 20, line 19). The system includes first means for accessing a descriptive profile of a potential recipient of the communication (Spec., Fig. 1, elements 22, 23, and 26; p. 58, lines 1-4; p. 61, line 20 – p. 62, line 2) and for identifying the potential recipient as a suggested recipient based on an evaluation of a correspondence between content of the communication and content of the descriptive profile of

the potential recipient (Spec., Fig. 1, elements 22, 23, and 26; Fig. 2, element 26; Fig. 23; p. 16, line 18 – p. 17, line 3; p. 58, lines 1-4; p. 61, line 20 – p. 62, line 2). The system further includes second means for presenting the suggested recipient to a sender of the communication for selection as a confirmed recipient (Spec., Fig. 1, elements 22, 23, and 26; Fig. 2, element 26; p. 58, line 14 et seq.; Fig. 18D, element 442) after the sender has composed a draft of the communication and before transmission of the communication to an actual recipient and for indicating the correspondence between the content of the communication and the content of the descriptive profile of the potential recipient (Fig. 1, elements 22, 23, and 26; Fig. 2, element 26; Fig. 23; Spec., p. 57, lines 7-11; Fig. 18A, elements 401 & 404).

As set forth in independent claim 28, the invention is a machine-readable medium storing a sequence of instructions that, when executed by a machine, cause the machine to execute a method to address a communication for transmission over a network. In the method, a descriptive profile of a potential recipient of a communication is accessed (Spec., p. 58, lines 1-4; p. 61, line 20 – p. 62, line 2). The potential recipient is then identified as a suggested recipient of the communication, based on an evaluation of a correspondence between content of the communication and content of the descriptive profile of the potential recipient (Spec., p. 16, line 18 – p. 17, line 3; p. 58, lines 1-4; p. 61, line 20 – p. 62, line 2). The suggested recipient is then presented to a sender of the communication, for selection as a confirmed recipient (Spec., p. 58, line 14 et seq.; Fig. 18D, element 442), after the sender has composed a draft of the

communication and before transmission of the communication to an actual recipient (Spec., p. 57, lines 7-11; Fig. 18A, elements 401 & 404). The suggested recipient is presented to the sender in conjunction with an indication (Fig. 18D) of the correspondence between the content of the communication and the content of the descriptive profile of the potential recipient (Spec., p. 58, line 22 – p. 59, line 10).

VI. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

Claims 1-13 and 27-28 are rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 5,835,087 of Herz et al. ("Herz").

VII. ARGUMENT

Herz fails to anticipate the present invention. A claim is anticipated only if each and every element in the claim is found in a single prior art reference. *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ.2d 1051, 1053 (Fed. Cir. 1987). Furthermore, the elements in the prior art reference must be arranged as required by the claim. *In re Bond*, 910 F.2d 831, 15 USPQ.2d 1566 (Fed. Cir. 1990). The present rejections do not meet either of these requirements.

Claim 1 is representative of all of Applicants' claims for purposes of this appeal, and recites:

1. A method of addressing a communication for transmission over a network, the method including:
 - accessing a descriptive profile of a potential recipient of the communication;
 - identifying the potential recipient as a suggested recipient of the communication based on an evaluation of a correspondence between content of the communication and content of the descriptive profile of the potential recipient; and

presenting the suggested recipient to a sender of the communication for selection as a confirmed recipient after the sender has composed a draft of the communication and before transmission of the communication to an actual recipient, the suggested recipient being presented in conjunction with an indication of the correspondence between the content of the communication and the content of the descriptive profile of the potential recipient. (Emphasis added).

Herz does not disclose or even suggest such a method. In particular, Herz fails to disclose or suggest identifying a potential recipient of a communication as a suggested recipient based on an evaluation of a correspondence between content of the communication and content of the descriptive profile of the potential recipient, and then presenting the suggested recipient to a sender of the communication for selection as a confirmed recipient, much less doing so after the sender has composed a draft of the communication and before transmission of the communication to an actual recipient. Indeed, Herz does not even relate to any technique for addressing a communication, as the present invention does.

A brief description of Herz may be helpful here. Herz relates to a system that automatically identifies objects (e.g., information or other people) that a user may be interested in or that the user may find "desirable". To accomplish this, the system of Herz automatically constructs two types of profiles: "target profiles" and "target profile interest summaries". A target profile is built for each "target object" to describe that object. A "target object" is information (e.g., news or advertising) or a person that a user might find desirable. A "target profile interest summary" is generated for each user, to summarize the types of target objects in which the particular user is interested. The system then evaluates the various target profiles against the users' target profile interest summaries to generate a user-customized ranked list of target objects most likely to be of interest to each user. Each user is then allowed to select from the list of target objects. See Herz abstract and col. 5, lines 7-20.

In contrast with claim 1, however, Herz does not disclose or suggest presenting the suggested recipient to a sender of the communication for selection as a confirmed recipient, much less doing so after the sender has composed a draft of the communication and before transmission of the communication to an actual recipient.

The Examiner interprets a "target object" in Herz as the "recipient" in Applicants' claims, as indicated in the Advisory Action mailed on 11/17/2006, in which the Examiner states:

Applicants argue that the target object can not be a recipient. In response to Applicant's argument, the Patent Office maintain [*sic*] the rejection because Hertz discloses a target object which is receive [*sic*] an e-mail. Therefore, Examiner interpreted a target object as a recipient [*sic*] as shown in in [*sic*] col.6, lines 12-13 is defined (the target object can include, but are [*sic*] not limited to: e.g., e-mail to receive, or another person to a correspond with) having a function as recipient. **Therefore, the Examiner interpreted "target object" as a "recipient".**

Applicants argue that Hertz does not teach and evaluation of a correspondence between content of these profiles of potential recipient and content of the communication. In response to Applicant's argument, the Patent Office maintain [*sic*] the rejection because **Hertz teaches an evaluation of a correspondence between content of these profiles of potential recipient [*sic*] and content of the communication** as shows [*sic*] in col. 5, lines 7-20, and col. 18, lines 7-36. Hertz clearly the applicant claimed invention. Advisory Action, continuation sheet (emphasis added).

The Examiner's interpretation of Herz is not consistent with the claim language. Note first that Herz states, "The target objects may be published articles, purchasable items, or even other people. . . . Examples of target objects can include, but are not limited to: a newspaper story of potential interest, a movie to watch, an item to buy, e-mail to receive, or another person to correspond with." Col. 6, lines 7-13 (emphasis added).

Now bearing in mind that the Examiner interprets a "target object" in Herz as the "recipient" in Applicants' claims, consider the following possible scenarios:

Assuming a scenario in which the "target object" in Hertz is an "e-mail to receive" (which is one example disclosed in Herz), then the recipient in that scenario (i.e., the "user" in Herz) is not presented to the sender of the communication (the target object) for selection as a confirmed recipient, as required by claim 1. In Hertz, only the user (the recipient in this scenario) decides whether he will actually see the email (target object) in this scenario (see col. 5, lines 17-18), not the sender or even the system. Therefore, this scenario does not read on claim 1.

Now assume a different scenario, in which the "target object" in Hertz is "another person to correspond with" (another example disclosed in Herz): If the "potential recipient" in claim 1 is interpreted to be that "[a]nother person to correspond with", the system in Herz does not identify that person (the target object) as a suggested recipient based on any evaluation of content of a communication that may be sent to that person (relative to the recipient's profile), as required by claim 1. (The absence of such disclosure is not surprising, since Herz does not relate to a technique of addressing a communication.)

On the other hand, if the "potential recipient" in claim 1 is interpreted in this scenario to be the user himself in Herz, then the system in Herz does not suggest that person (the user) as a recipient to the other person (the sender in this case) at all, much less doing so based on an evaluation of content of a communication that may be sent to the user. Therefore, this second scenario (i.e., where the target object is "another person to correspond with") also does not read on claim 1.

Indeed, there is no interpretation of Hertz which reads on claim 1 of the present application. That is, there is no interpretation of Hertz by which Herz discloses or even suggests all of the limitations of claim 1, and in particular, presenting the suggested recipient to a sender of the communication for selection as a confirmed recipient, after the sender has composed a draft of the communication and before transmission of the communication to an actual

recipient. Therefore, claim 1 and all claims which depend on it are patentable over the cited art.

Each of Applicants' other independent claims includes limitations similar to those discussed above. Therefore, all pending claims are patentable over the cited art.

Dependent Claims

In view of the above remarks, a specific discussion of the dependent claims is considered to be unnecessary. Therefore, Applicant's silence regarding any dependent claim is not to be interpreted as an agreement with, or acquiescence to, the rejection of such claim or as waiving any argument regarding the claim.

VIII. CONCLUSION

For the above-stated reasons, Appellant respectfully requests the Board reverse the rejections of claims 1-13 and 27-28 and direct the Examiner to enter a Notice of Allowance for those claims.


Deposit Account Authorization

Authorization is hereby given to charge our Deposit Account No. 02-2666 for any charges that may be due. Furthermore, if an extension is required, then Appellant hereby requests such extension.

Respectfully submitted,

BLAKELY, SOKOLOFF, TAYLOR & ZAFMAN LLP

Date: August 31, 2009


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APPENDIX A – CLAIMS ON APPEAL

1. (Previously presented) A method of addressing a communication for transmission over a network, the method including:
 - accessing a descriptive profile of a potential recipient of the communication;
 - identifying the potential recipient as a suggested recipient of the communication based on an evaluation of a correspondence between content of the communication and content of the descriptive profile of the potential recipient; and
 - presenting the suggested recipient to a sender of the communication for selection as a confirmed recipient after the sender has composed a draft of the communication and before transmission of the communication to an actual recipient, the suggested recipient being presented in conjunction with an indication of the correspondence between the content of the communication and the content of the descriptive profile of the potential recipient.
2. (Original) The method of claim 1 wherein the indication of the correspondence includes an identification of a portion of the content of the communication that corresponds to the content of the descriptive profile of the potential recipient.
3. (Previously presented) The method of claim 2 wherein the communication comprises an electronic document, and the identification comprises

identification of the portion of the content of the electronic document that corresponds to the content of the descriptive profile.

4. (Previously presented) The method of claim of 3 wherein the identification of the portion of the content of the electronic document includes identifying textual terms within the electronic document.
5. (Previously presented) The method of claim 4 wherein the identification of the textual terms includes identifying the textual terms within the body of the electronic document.
6. (Previously presented) The method of claim 5 wherein the identification of the textual terms within the body of the electronic document includes visually differentiating textual terms which correspond to terms of the descriptive profile.
7. (Previously presented) The method of claim 1 further including, responsive to sender identification of the suggested recipient, identifying a portion of the content of the communication corresponding to the content of the descriptive profile of the suggested recipient.
8. (Previously presented) The method of claim 1 further including accessing a plurality of descriptive profiles of a plurality of potential recipients of the communication, identifying a plurality of the potential recipients as suggested

recipients, presenting the plurality of suggested recipients to the sender, and, responsive to sender identification of a portion of the content of the communication, identifying to the sender at least one of the plurality of potential recipients based on a correspondence between the sender-identified portion of the content of the communication and content of a descriptive profile for the at least one of the plurality of potential recipients.

9. (Original) The method of claim 8 wherein the sender-identified portion of the content of the communication includes a plurality of terms of an electronic document.
10. (Previously presented) The method of claim 1 further including presenting an indication of a strength of the correspondence between the content of the communication and the content of the descriptive profile for the potential recipient.
11. (Previously presented) The method of claim 1 further including presenting a plurality of suggested recipients to the sender together with an indication, for each of the plurality of suggested recipients, of a strength of a correspondence between the content of the communication and content of a respective descriptive profile for each of the plurality of suggested recipients.
12. (Previously presented) The method of claim 11 further including ranking the plurality of suggested recipients according to the respective strength of the

correspondence between the content of the communication and the content of the respective descriptive profile for each of the plurality of suggested recipients.

13. (Previously presented) The method of claim 1 further including prompting the sender for a filter criterion prior to accessing the descriptive profile, and applying the filter criterion in the identification of the potential recipient.

14 – 26. (Canceled)

27. (Previously presented) A system for addressing a communication for transmission over a network, the system including:

first means for accessing a descriptive profile of a potential recipient of the communication and for identifying the potential recipient as a suggested recipient based on an evaluation of a correspondence between content of the communication and content of the descriptive profile of the potential recipient; and

second means for presenting the suggested recipient to a sender of the communication for selection as a confirmed recipient after the sender has composed a draft of the communication and before transmission of the communication to an actual recipient and for indicating the correspondence between the content of the communication and the content of the descriptive profile of the potential recipient.

28. (Previously presented) A machine-readable medium storing a sequence of instructions that, when executed by a machine, cause the machine to execute a method to address a communication for transmission over a network, the method to include:

- accessing a descriptive profile of a potential recipient of the communication;

- identifying the potential recipient as a suggested recipient based on an evaluation of a correspondence between content of the communication and content of the descriptive profile of the potential recipient; and

- presenting the suggested recipient to a sender of the communication for selection as a confirmed recipient after the sender has composed a draft of the communication and before transmission of the communication to an actual recipient, the suggested recipient being presented in conjunction with an indication of the correspondence between the content of the communication and the content of the descriptive profile of the potential recipient.

APPENDIX B – EVIDENCE

None

APPENDIX C – RELATED PROCEEDINGS

None